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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
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2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/530,334

Applicant(s)

ROVER ET AL.

Examiner

Minh Dieu Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-40 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 41-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-40 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/14/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/15/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/2006 has been entered.

Information Disclosure Statement

2. The information disclosure statement filed 11/15/2006 has been placed in the application file except item FD is not provided and the information referred to therein has been considered as to the merits.

Claim Objections

3. Claims 13 and 21 are objected to because of the following informalities:

a) As to claim 13, the phrase "transmitting the message to be signed from the receiver" should be "transmitting the message to be signed from the first receiver".

b) As to claim 21, the phrase "A signed message created by the process of Claim 13" should be "The method according to Claim 13, wherein a signed message is created".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 13 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 13 and 34 contain "transmitting the signed message to at least one of the first receiver **and** at least one other receiver" which was not described in the specification, page 5, lines 37-39 ("the message 3 to be signed is being signed upon instruction by the user and the signed message 9 is passed on to the receiver 5 **or** to some other receiver").

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: transmitting the signed message to at least one of the first receiver and at least one other receiver.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-40 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonstromer (6,142,369) in view of Falk et al. (5,668,876).

a) As to claim 13, as best understood, Jonstromer discloses a method for digital signing of a message (e.g. electronic credits) which is transmitted via a communication network to a signing unit (see Jonstromer: col. 1, lines 7-44) comprising signing the message to be signed via the mobile radio telephone (i.e. smart card is configured for use as an electronic wallet and as a mobile phone SIM, see Jonstromer: col. 3, lines 7-8, smart card can store electronic credits, representing money, which can be transferred by electronic means from a payer, the owner of the smart card, to a payee, see Jonstromer: col. 1, lines 10-13), thereby forming a signed message, the signed message signifying a user's intent to deliver the signed message and its content (i.e. a smart card can be used to control fund transfer from one bank account to another by having the payer enters details of his own bank account and his bank's address, (this information may be pre-stored on the smart card), the amount of money to be transferred and the payee's bank account number. This information is used to formulate a signal containing payer's bank account, payer's electronic signature, payee's bank account and the amount to be transferred, see Jonstromer: col. 6, lines 14-34, the

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payer's electronic signature including in the signal indicates the message is signed); transmitting the message to at least one of the first receiver or at least one other receiver (i.e. transmitting a signal indicating the amount to be transferred, the address of the payee, the account number and an electronic signature of the payer to an electronic banking terminal at the bank, see Jonstromer: col. 6, lines 35-36) and communicating the message to an addressee (i.e. transmitting a signal to the payee's till indicating the amount transferred and the identity of the payer, see Jonstromer: col. 6, lines 39-41). However, Jonstromer is silent on transmitting from a transmitter a message to be signed to a first receiver and transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone, the telephone network comprising a mobile radio telephone network. Falk is relied on for the teaching of transmitting from a transmitter a message to be signed to a first receiver (e.g. transmitting user's account number from a user's radio telephone terminal (see Falk: Fig. 1, element 22; col. 3, lines 9-14) to a bank, see Falk: col. 7, lines 30-31) and transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone, the telephone network comprising a mobile radio telephone network (i.e. the bank transmits a challenge code (i.e. the challenge code is unique to a given transaction, see Falk: col. 4, lines 46-48, so it directly ties to user's account number in a given transaction) to a personal unit associated with user's radio telephone terminal (i.e. see Falk: Fig. 1, element 20; the personal unit can be used with a radio telephone without any modification or customization, see Falk: col. 2, lines 22-26, the personal unit includes an algorithm unit, see Falk: Fig. 2, element 21b, which calculates a response code

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based on the received challenge code, see Falk: col. 4, lines 62-64, the response code is unique to a given transaction and is used to authorize service to user). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of transmitting from a transmitter a message to be signed to a first receiver and transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone, the telephone network comprising a mobile radio telephone network in the system of Jonstromer, as Falk teaches, so as to provide a secure electronic services such as banking services (see Falk: col. 1, lines 10-15).

b) As to claim 14, the combination of Jonstromer and Falk discloses the method of claim 13, wherein a public key process is used for signing (i.e. SIM, in the form of chipcard, includes encryption algorithm and keys, the encryption involves the use of asymmetric ciphers, public and private key pair, which enable both secure encryption (i.e. one key is used for encryption and the other key is used for decryption) and the use of secure electronic signatures (i.e. one key is used for signing and the other key is used for verifying), see Jonstromer: col. 1, lines 28-44; col. 4, lines 47-52), particularly a public-key process in which said signing unit has an associated secret key (see Jonstromer, col. 4, lines 37-41) and, in particular, the receiver has a corresponding public key so that the signed message transmitted to the receiver can, optionally, be compared with the original message and identified as authentic (see Jonstromer, col. 6, lines 36-41).

c) As to claim 15, the combination of Jonstromer and Falk discloses the method of claim 13, wherein the message to be signed is transmitted between the

receiver and the mobile radio telephone by means of a short-message service (SMS) (i.e. Jonstromer discloses transmission over GSM system, see Jonstromer: col. 1, lines 39-41, in GSM standard, SMS is a service for sending short messages (up to 160 characters) to mobile phones).

d) As to claim 16, the combination of Jonstromer and Falk discloses the method of claim 13, wherein, prior to signing, the message to be signed is displayed by means of a display provided in the mobile radio telephone (see Jonstromer: Fig. 1, element 6).

e) As to claim 17, the combination of Jonstromer and Falk discloses the method of claim 14, wherein the secret key required for signing is inputted via keyboard on the mobile radio telephone (see Jonstromer: col. 6, lines 18-34).

f) As to claim 18, the combination of Jonstromer and Falk discloses the method of claim 14, wherein the secret key required for signing is stored on a chip card of the mobile radio telephone, the secret key being activated by a personal identification number (PIN) adapted to be inputted via a keyboard on the mobile radio telephone (i.e. asymmetric ciphers in SIM, a form of chipcard, of a mobile phone includes secret key for signing, SIM is activated by user entering his PIN, see Jonstromer: col. 1, lines 28-44).

g) As to claim 19, the combination of Jonstromer and Falk discloses the method of claim 18, wherein the chipcard performs said signing step (i.e. SIM carries variety of information about a mobile telephone subscriber and the service he is entitled to access, SIM includes encryption algorithms and keys and the encryption employed

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frequently involves the use of asymmetric ciphers, which enable both secure encryption and the use of secure electronic signatures, i.e. digital signing, see Jonstromer: col. 1, lines 28-44).

h) As to claim 20, the combination of Jonstromer and Falk discloses the method of claim 18, wherein the mobile radio telephone performs the signing step and wherein the secret key is read from the chip card (i.e. SIM carries variety of information about a mobile telephone subscriber and the service he is entitled to access, SIM includes encryption algorithms and keys and the encryption employed frequently involves the use of asymmetric ciphers, i.e. public and private key pair, which enable both secure encryption and the use of secure electronic signatures, i.e. digital signing where private key is used for signing and public key is used for verifying, see Jonstromer: col. 1, lines 28-44).

i) As to claim 21, the limitation of this claim is addressed in claim 13 above.

j) As to claim 22, Jonstromer discloses a method for digitally signing, by means of a signing apparatus, a message (e.g. electronic credits) to be transmitted to a receiving device (see Jonstromer: col. 1, lines 7-44), characterized in that the message is then signed in the signing apparatus (i.e. the message is signed by the payer and the signed message contains in a signal including payer's bank account, payer's electronic signature, payee's bank account and the amount to be transferred (see Jonstromer: col. 6, lines 30-34). Jonstromer is silent of the capability of the message to be signed is transmitted from a transmitting device to a receiving device, this message is then transmitted from the receiving device via a telephone network to a signing apparatus

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associated with the transmitting device and transmitted back to the receiving device as a signed message. Falk is relied on for the teaching of the message to be signed is transmitted from a transmitting device to a receiving device (e.g. transmitting user's account number from a user's radio telephone terminal (see Falk: Fig. 1, element 22; col. 3, lines 9-14) to a bank, see Falk: col. 7, lines 30-31), this message is then transmitted from the receiving device via a telephone network to a signing apparatus associated with the transmitting device (i.e. the bank transmits a challenge code (i.e. the challenge code is unique to a given transaction, see Falk: col. 4, lines 46-48, so it directly ties to user's account number in a given transaction) to a personal unit associated with user's radio telephone terminal (i.e. see Falk: Fig. 1, element 20; the personal unit can be used with a radio telephone without any modification or customization, see Falk: col. 2, lines 22-26, the personal unit includes an algorithm unit, see Falk: Fig. 2, element 21b, which calculates a response code based on the received challenge code, see Falk: col. 4, lines 62-64, the response code is unique to a given transaction and is used to authorize service to user) and transmitted back to the receiving device as a signed message (i.e. the response code is sent back to the service node (e.g. bank, see Falk: Fig. 1, element 26), the signed message issue is addressed by Jonstromer). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of the message to be signed is transmitted from a transmitting device to a receiving device, this message is then transmitted from the receiving device via a telephone network to a signing apparatus associated with the

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transmitting device in the system of Jonstromer, as Falk teaches, so as to provide a secure electronic services such as banking services (see Falk: col. 1, lines 10-15).

k) As to claim 23, the limitation of this claim is similar to claim 19, a chipcard is part of the mobile telephone, therefore it is rejected by a similar rationale applied against claim 19 above.

l) As to claim 24, the combination of Jonstromer and Falk discloses the method according to claim 23, wherein the telephone network is a mobile telephone network (see Jonstromer: col. 4, lines 15-16).

m) As to claim 25, the limitation of this claim is similar to claim 14, therefore it is rejected by a similar rationale applied against claim 14 above.

n) As to claim 26, the limitation of this claim is similar to claim 15, therefore it is rejected by a similar rationale applied against claim 15 above.

o) As to claim 27, the limitation of this claim is similar to claim 16, therefore it is rejected by a similar rationale applied against claim 16 above.

p) As to claim 28, the limitation of this claim is similar to claim 17, therefore it is rejected by a similar rationale applied against claim 17 above.

q) As to claim 29, the limitation of this claim is similar to claim 18, therefore it is rejected by a similar rationale applied against claim 18 above.

r) As to claim 30, the limitation of this claim is similar to claim 19, therefore it is rejected by a similar rationale applied against claim 19 above.

s) As to claim 31, the limitation of this claim is similar to claim 20, therefore it is rejected by a similar rationale applied against claim 20 above.

t) As to claim 32, the combination of Jonstromer and Falk discloses the method according to claim 22, wherein the signing apparatus serves in addition as a transmittor to transmit the signed message to the receiving device (see Jonstromer: col. 3, lines 50-53).

u) As to claim 33, Jonstromer discloses a chip card for a mobile telephone (i.e. mobile phone use SIM, subscriber information module, which are in the form of smart card. SIM carries mobile telephone subscriber and the service one is entitled to access, SIM includes encryption algorithms and keys, see Jonstromer: col. 1, lines 29-34), wherein the chipcard incorporates a signing device which has a memory unit for storing a private key necessary for producing a signed message (i.e. asymmetric ciphers enable secure encryption and the use of secure electronic signatures, see Jonstromer: col. 1, lines 41-44), characterized in that the signing device generates the signed message (i.e. the signed message contains in a signal including payer's bank account, payer's electronic signature, payee's bank account and the amount to be transferred (see Jonstromer: col. 6, lines 30-34). Jonstromer is silent on having the message to be signed which is received by the mobile telephone via a telephone network. Falk is relied on for the teaching of having the message to be signed which is received by the mobile telephone via a telephone network (i.e. the bank transmits a challenge code (i.e. the challenge code is unique to a given transaction, see Falk: col. 4, lines 46-48, so it directly ties to user's account number in a given transaction) to a

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personal unit associated with user's radio telephone terminal (i.e. see Falk: Fig. 1, element 20; the personal unit can be used with a radio telephone without any modification or customization, see Falk: col. 2, lines 22-26, the personal unit includes an algorithm unit, see Falk: Fig. 2, element 21b, which calculates a response code based on the received challenge code, see Falk: col. 4, lines 62-64, the response code is unique to a given transaction and is used to authorize service to user). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having the message to be signed which is received by the mobile telephone via a telephone network in the system of Jonstromer, as Falk teaches, so as to provide a secure electronic services such as banking services (see Falk: col. 1, lines 10-15).

v) As to claim 34, the limitations of this claim are similar to those of claim 13, therefore it is rejected by a similar rationale applied against claim 13 above.

w) As to claim 35, the limitation of this claim is similar to claim 14, therefore it is rejected by a similar rationale applied against claim 14 above.

x) As to claim 36, the limitation of this claim is similar to claim 15, therefore it is rejected by a similar rationale applied against claim 15 above.

y) As to claim 37, the limitations in this claim are part of claim 34 and are rejected by a similar rationale applied against claim 34 above.

z) As to claim 38, the limitations in this claim are part of claim 34 and are rejected by a similar rationale applied against claim 34 above.

aa) As to claim 39, Jonstromer discloses a method comprising the user using the mobile radio telephone to generate a signed message corresponding to the received

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message (i.e. the signed message contains in a signal including payer's bank account, payer's electronic signature, payee's bank account and the amount to be transferred (see Jonstromer: col. 6, lines 30-34) and the user initiating transmission of the signed message via the use of the mobile radio telephone into the telephone network so as to communicate the signed message to an addressee (i.e. the communications module transmit a signal indicating the amount to be transferred, the address of the payee, the account number and an electronic signature of the payer to an electronic banking terminal at the bank, see Jonstromer: col. 3, lines 50-53). Jonstromer is silent on the capability of having a mobile radio telephone user receiving a message from a telephone network. Falk is relied on for the teaching of having a mobile radio telephone user receiving a message from a telephone network (i.e. the bank transmits a challenge code (i.e. the challenge code is unique to a given transaction, see Falk: col. 4, lines 46-48, so it directly ties to user's account number in a given transaction) to a personal unit associated with user's radio telephone terminal (i.e. see Falk: Fig. 1, element 20; the personal unit can be used with a radio telephone without any modification or customization, see Falk: col. 2, lines 22-26, the personal unit includes an algorithm unit, see Falk: Fig. 2, element 21b, which calculates a response code based on the received challenge code, see Falk: col. 4, lines 62-64, the response code is unique to a given transaction and is used to authorize service to user). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having the message to be signed which is received by the mobile telephone via a telephone

network in the system of Jonstromer, as Falk teaches, so as to provide a secure electronic services such as banking services (see Falk: col. 1, lines 10-15).

ab) As to claim 40, the limitation of this claim is similar to claim 14, therefore it is rejected by a similar rationale applied against claim 14 above.

ac) As to claim 46, Jonstromer discloses a wireless device for receiving a message to be signed and transmitting a corresponding signed message, said device comprising: an antenna for receiving and transmitting messages (see Jonstromer: Fig. 2, element 8); a display for displaying a message (see Jonstromer: Fig. 2, element 6); input apparatus for accepting input from a user indicating the received message is to be signed (i.e. user enters his PIN to activate SIM functionality such as signing, see Jonstromer, col. 1, lines 33-38); and memory for storing an algorithm for generating a corresponding signed message (i.e. chipcard with memory acts as a SIM for the mobile phone, SIM carries a variety of information including asymmetric ciphers, keys for encryption and electronic signing, see Jonstromer: col. 1, lines 28-44). Jonstromer is silent on the capability of a wireless device receiving a received message via an antenna to be displayed on a display. Falk is relied on for the teaching of having a wireless device receiving a message from a telephone network via an antenna (i.e. the bank transmits a challenge code (i.e. the challenge code is unique to a given transaction, see Falk: col. 4, lines 46-48, so it directly ties to user's account number in a given transaction) to a personal unit associated with user's radio telephone terminal (i.e. see Falk: Fig. 1, element 20; the personal unit can be used with a radio telephone without any modification or customization, see Falk: col. 2, lines 22-26, the personal

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unit includes a display unit, see Falk: col. 4, lines 1-8, an algorithm unit, see Falk: Fig. 2, element 21b, which calculates a response code based on the received challenge code, see Falk: col. 4, lines 62-64, the response code is unique to a given transaction and is used to authorize service to user). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having the message to be signed which is received by the mobile telephone via a telephone network in the system of Jonstromer, as Falk teaches, so as to provide a flexible way of sending messages to be signed rather than manually entering data to the phone system for signing, therefore making automation is more effective (see Falk: col. 4, lines 38-45).

ad) As to claim 47, the combination of Jonstromer and Falk discloses the wireless device of claim 46 wherein the wireless device is a mobile radio telephone (see Jonstromer: Fig. 1, element 4).

ae) As to claim 48, the combination of Jonstromer and Falk discloses the wireless device of claim 46 wherein said memory for storing an algorithm is located within a chip card of said wireless device (i.e. an algorithm is located within a SIM, which is in the form of a chip card, see Jonstromer: col. 1, lines 28-44).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



mdh

12/26/06